

REMARKS

In this application, claims 1-30 are pending, and they were the subject of a full examination, the results of which were discussed in an Office Action dated January 12, 2006. A response demonstrating the allowability of the claims was filed on May 3, 2006.

The currently pending Office Action, however, makes both restriction and election requirements. For the reasons detailed below, Examiner Reimers is respectfully requested to reconsider and withdraw these requirements.

The restriction requirement identified two groups of claims, characterized as follows:

- I. Claims 1-37 are drawn to tether, classified in class 606, subclass 74.
- II. Claims 38-58, drawn to method for treating an orthopedic defect, classified in class 623, subclass 17.11.

The above language concerning the Examiner's groups is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicants as to the subject matter or classification of any claim.

As Examiner Reimers' restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the examiner. Accordingly, Applicants elect group I (claims 1-37) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious burden. For example, method claims 38-58 include securing a tether to a bone portion, the tether comprising a cord, a first sheath and a radiopaque element. Likewise, apparatus claim 1 recites a tether comprising a cord, a first sheath and a radiopaque element. Searching and

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consideration of references regarding one set of claims will thus be identical or at least overlap to a very great extent. Put another way, most or all of the references, if any, that are relevant to one set of claims will likely be relevant to the other set of claims. Since the research and analysis effort required for examining one set of claims will be essentially the same as for examining both sets of claims, it is respectfully submitted that there will be no significant extra burden in searching and examining both sets of claims. Per MPEP 803 and 808.02, the restriction requirement should be withdrawn and all pending claims should be examined.

The pending Office Action also made a requirement for election of species. This requirement is also traversed. Examiner Reimers indicated the opinion that this application includes claims directed to more than one species "of the claimed invention." Specifically, the following species were identified:

Species 1: Figure 1

Species 2: Figures 2 and 3

Species 3: Figure 4

Species 4: Figure 5

The listing above is taken from the Office Action, and is not intended as an admission of any sort by Applicants as to the subject matter of any claim or as to any embodiment disclosed in the application.

The Examiner relied on 35 U.S.C. § 121 in requesting that Applicant elect a single species. Applicant elects species 1, corresponding to FIG. 1, with traverse. All of claims 1-58 are readable on the embodiment of FIG. 1. Applicants submit that at least claims 1, 36, and 37

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are generic claims, but reserve the right to claim genericness of other claims later as may be appropriate.

Further, examination of the claims with reference to all of the disclosed embodiments would not be burdensome, and would promote efficiency. Indeed, in this case it cannot be persuasively argued that examination of all claims would cause significant additional burden on the Examiner, principally because a search and examination has already been conducted on the entirety of this application. That fact clearly demonstrates that a proper search and consideration of all of the subject matter not only can be made, but it can be made efficiently and in good time. Moreover, with the search results and initial analysis already of record in this case, any further necessary searching or consideration will be merely updating prior work. In other words, the Examiner's burden going forward is quite small compared with the task already completed. Thus, whether considered in the abstract or in light of the actual status of this case, there is no basis to contend that considering all alleged species will require substantially more effort than considering only one.

It is respectfully submitted that the election requirement should also be withdrawn because a proper *prima facie* case for the requirement has not been established. The sole basis for the requirement was that the alleged species "have different structural limitations, e.g. a single fiber cord versus a multiple fiber cord." However, no basis for treating the stated different structure separately were given in the Office Action. "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate." MPEP 808.01 (emphasis added); see also MPEP 803 ("Examiners must provide reasons and/or examples to support

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conclusions). No discussion of the grounds for that conclusion were provided. Because the MPEP defines a conclusion of restrictability without basis to be inadequate, the requirement should be withdrawn.

Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. If "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP 808.02. The Office Action does not allege that the classification of the alleged species is different, and it seems likely that all such species would be commonly classified. The Office Action asserts that the crowded art causes a difficulty, but it is submitted that the same art categories would be consulted for each alleged species. It is not apparent from the record that any searching would be necessary for one species "that is not likely to find art pertinent to the other[s]." *Id.* Rather, it is believed that any practical and reasonable search strategy for one species would find references pertinent to all species. Finally, no suggestion was provided that the alleged species would be separately classified or searchable in the future. No patents or other evidence of a separate field of search was provided, as MPEP 808.02 requires. For these additional reasons, the election requirement should be withdrawn.

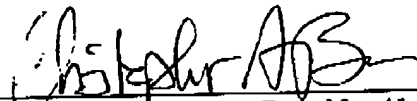
The separation of Figures 4 and 5 of this application into separate species is not understood. The specification and drawings indicate that those figures are representations of possible uses for any of the embodiments of the subject matter described in the application. There appears to be no basis for differentiating the drawings in Figures 4 and 5 from the drawings of any of Figures 1-3, and thus no basis for creating separate species for them.

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Applicants do not concede the propriety of the Examiner's requests, and do not intend to limit in any way the scope of the claims with the statements or provisional elections herein. Specifically, the claims in this application should be given the full scope permitted by their language. Applicants reserve the right to later assert that other claims are generic or read on the provisionally-elected species as well, especially if the election requirement is not withdrawn. No amendments have been made to the claims, and no new matter has been added.

In conclusion, Applicants have provisionally elected claims 1-37 of this application, with traverse, in response to the present restriction requirement. Applicants also have provisionally elected species 1 with traverse. It is respectfully requested that Examiner Reimers reconsider the present restriction and election requirements and withdraw them for at least the reasons given above. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,



Christopher Al Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

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